

Appl. No. 10/622,518
Docket No. AA598M
Amdt. dated Jan. 12, 2007
Reply to Office Action of Oct. 12, 2006
Customer No. 27752

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REMARKS

Claim Status

Claims 1-13 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC §103(a)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. *See In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); MPEP § 2143.01. Second, there must be a reasonable expectation of success for the proposed modification. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143.02. Third, the prior art reference or combined references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP §2143.03. Furthermore, in establishing a *prima facie* case of obviousness, case law clearly places the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967).

Claims 1-13 have been rejected under 35 USC §103(a) as being unpatentable over the combination of European Publication No. 0063875A1 to Sadao Okamura ("EP '875"), U.S. Patent No. 5,747,022 to Craig Slavtcheff ("US '022"), and Japanese Abstract 242509 to Momoki Nakagawa ("JP '509"). In support of the rejection, the Office states that EP '875 teaches a facemask "prepared using nonwoven fabric or textile fabric and the textile fabric is made from cotton or synthetic resin." The Office further states that EP '875 "teaches that liquid ingredients, which have been used in the face pack, can be used as liquid ingredients and teaches that the liquid composition can have humectants, oily substance and other drugs." The Office concedes that EP '875 does not teach a face pack with the liquid composition claimed. The Office turns to US '022 and states that it "teaches [a] cosmetic mask using surfactant, oily components, and thickener . . . the polymer . . . water . . . silicone oils . . . [and] sorbitan fatty acid esters." The Office states

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that the examples of US '022 teach "using vitamins, but not the vitamins claimed in claim 7 as whitening agent." The Office presents JP '509 as teaching a "beauty pack containing ascorbic acid (claimed whitening agent)." The Office concludes:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare cosmetic mask of EP with liquid compositions having humectant and oily component and also add surfactant and thickener taught by patent '022 and add vitamin (ascorbic acid) taught by JP abstract. The idea of combining the ingredients flows logically from the art for having been used in the same cosmetic facemask art. One of ordinary skill in the art would be motivated to use liquid compositions having the ingredients taught by patent '022 and JP abstract with the reasonable expectation of success that the fabric face pack of '875 avoids the disadvantages [sic] taught by EP '875 for conventional face packs at pages 2-3 and has the advantage that the face pack can be dried quickly and it can be peeled off without leaving any flakes on the face and the addition of whitening agent (ascorbic acid) has the advantage of providing the consumer beauty effect taught by JP abstract.

Applicant traverses the rejection.

Initially, the Office has failed to address and to present references teaching each and every limitation of the present invention. Specifically, Claim 1 recites "an emulsified liquid composition." The Office has not presented a teaching within EP '875, US '022, or JP '509 directed a substrate-based mask having an emulsion composition

Next, the Office's attempted combination of EP '875 with US '022 is in error for several reasons. Before addressing the errors present in the combination, the teachings of each document should be addressed. EP '875 is directed to a cosmetic face mask comprising a sheet of material carrying liquid ingredients. EP '875 provides little guidance as to the appropriate liquid ingredients aside from a few exemplary ingredients (e.g., humectants and oily components) and general statement that "[l]iquid ingredients which have been used in the prior art fluid face packs can be used." Pg. 7, lines 1-2. US '022 relates to a quick drying composition that will harden into a peelable mask. In other words, US '022 is a substrate-free mask. US '022 *requires* the use of two polymers: a polyvinyl alcohol and a hydrophobically-modified acrylate or methacrylate polymer. The need for both of the polymers is clear from the language used in US '022 (e.g., "first necessary polymer" and "second critical component" – col. 2, line 53 to col. 3, line 20).

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US '022 does not relate to a substrate-based mask. The composition of US '022 is in the form of a gel or paste (col. 2, lines 10-14) that is applied to the face which then hardens to form a peelable mask. The errors in the attempted combination of EP '875 with US '022 are numerated below.

1. The Office is attempting to combine references without a full appreciation of the teachings therein. Case law states, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). EP '875 is directed to a substrate mask whereas US '022 is directed to a substrate-free mask. US '022 does not need a substrate such as disclosed in EP '875 because the polymers of the US '022 composition harden to form a substrate (e.g., a film). The Office is taking the polymers of the US '022 composition combining them with the EP '875 substrate. One skilled in the art would not combine the film forming composition of US '022 with a substrate mask of EP '875 because the material of one reference is redundant (i.e., a hardening peelable mask and a substrate mask).

2. The Office disregards the clear teaching away from the proposed combination. On pages 2-4, EP '875 recites numerous disadvantages of "fluid face packs" (e.g., such as the product disclosed in US '022). The disadvantages include washing or wiping the face pack from the fingers, remaining still until the face pack forms (i.e., hardens), peeling off the film mask, inability to easily remove all of the film mask from the face, production factors, etc. EP '875 states that it provides "an entirely new type of face pack which has none of the disadvantages that accompany production, storage and use of the prior art face packs." Pg. 4, lines 10-13. However, the Office is combining EP '875 with US '022, a reference directed to a peelable masks that embodies the disadvantages that EP '875 seeks to overcome. After considering the many disadvantages of peelable masks as presented in EP '875, one skilled in the art would not then rely on a reference teaching peelable masks as suggested by the Office.

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3. The Office has engaged in the picking and choosing of select portions of the US '022 reference to support the Office's proposed combination. Case law states, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986)(citation omitted). The Office states that one of ordinary skill in the art would take the mask of EP '875 having the humectant and oily component and "add surfactant and thickener taught by patent '022." The Office is simply picking those portions of US '022 for inclusion with EP '875 and disregarding the rest of the reference (*i.e.*, the clear teaching of a peelable mask that is not desired by EP '875). Such picking and choosing of the US '022 reference is prohibited.

4. The Office's motivation for the combination is conclusory and based on a selective reading of the references. The Office provides two statements directed to the motivation. The Office states that the "idea of combining the ingredients flows logically from the art for having been used in the same cosmetic facemask art." This statement is merely conclusory and is without support. Next, the Office states that one "would be motivated to use liquid compositions having the ingredients taught by patent '022 and JP abstract with the reasonable expectation of success that the fabric face pack of '875 avoids the disadvantaged [sic] taught by EP '875 for conventional face packs at pages 2-3 and has the advantage that the face pack can be dried quickly and it can be peeled off without leaving any flakes on the face." The Office has provided no factual support or line reasoning for this assertion. This motivation is based on a selective reading of the cited references. Furthermore, Applicant asserts that the proposed combination may lack the advantages posited by the Office.

The teaching that a mask can be dried quickly comes from US '022. Col. 1, lines 5-7 and col. 2, lines 48-52. However, this benefit is provided by the non-substrate mask of US '022 and the Office is only relying on the surfactant and thickener of US '022 (see page 3, last line of the previous Office Action). The advantage of quick drying comes from the composition (*i.e.*, the invention as a whole) of US '022 and not just the use of

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the surfactant and thickener. The Office has not provided a sufficient factual basis or line of reasoning to support the motivation.

The teaching that a mask "can be peeled off without leaving any flakes on the face" comes from EP '875 and is presented as an advantage over fluid face packs that leave unpeeled pieces of the film on the face. Pg. 7, lines 25-26 and pg. 3, lines 10-13. US '022 falls within the definition of a fluid face pack which provides a film-forming mask. Col. 2, lines 48-51. Therefore, US '022 may leave pieces of film on the face of a user, which is undesirable according to EP '875. The Office's states that the proposed combination possesses the advantage of the EP '875 mask even though the proposed combination includes components of US '022, which contradicts this advantage. Again, the Office has not provided a sufficient factual basis or line of reasoning to support the motivation.

When considering the Office's motivation, it becomes clear that the Office's has selected advantages taught by the individual references without consideration of whether these advantages are possessed by the proposed combination. In the first instance (*e.g.*, face pack can be dried quickly), the Office relies on the advantage as taught by US '022 even though the proposed combination does not possess key elements of the US '022 mask. In the second instance (*e.g.*, face pack can be peeled off without leaving any flakes), the Office relies solely on the advantage as taught by EP '875 even though this advantage contradicts the film-forming mask as taught by US '022. As a result the Office has failed to meet its factual burden in support of a *prima facie* case of obviousness.

With regard to Claim 5, the Office takes the combination of EP '875 and US '022 and further adds the Japanese Abstract JP '509. JP '509 is directed to beauty pack having one or more chitosan layers and past layers containing effective ingredients help between a support sheet and a peel sheet. Applicants assert that the Office has failed to establish a *prima facie* case of obviousness on grounds that factually inquiries as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) have not been applied to JP '509. Specifically, the Office has not determined the scope and contents of JP '509 and has not ascertained the differences between JP '509 and the claims at issue. Furthermore, it must be noted that

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JP '509 does not solve the many issues, as presented above, related to the combination of EP '875 and US '022.

In light of the discussion provided above, a *prima facie* case of obviousness has not been made. Applicant respectfully requests the withdrawal of the § 103(a) rejection.

Double Patenting

Claims 1-13 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-12 of copending Application No. 10/630,493. In support of this rejection, the Office states that "the expression 'comprising' in the instant application is inclusive of skin toning agent claimed in [sic] the copending application and the express 'comprising' in the co-pending application is inclusive of oily component and surfactant claimed in [sic] the instant application." Applicant traverses the rejection.

First, the Office has failed to provide adequate support for the rejection. Case law mandates that the analysis of obviousness-type double patenting parallels the guidelines for a § 103 rejection. *In re Longi*, 759 F.2d 887, 892 n.4 (Fed. Cir. 1985). In the present rejection, the Office has failed to apply the factual inquiries as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Additionally, the Office has failed to present a rationale on how the copending application teaches each and every limitation in the claims of the present application. It must be noted that in determining obviousness within the context double patenting, the disclosure of the copending application may not be used as prior art. See *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1281 (Fed. Cir. 1992) ("Our precedent makes clear that the disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the disclosure is found in the claims.").

Second, the Office's reliance on the "comprising" language in the copending application is misplaced. If all that is required for a reference to be obviating is the open-ended "comprising" language, the obviousness standard would be swallowed by the fact that "comprising" is in virtually all patents. Instead, the obviousness determination requires application of the Graham factors as well as the three criteria: (1) a suggestion or

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motivation to modify the reference or combine the reference teachings, (2) a reasonable expectation of success for the proposed modification, and (3) the teaching of all the claim limitations.

In light of the discussion provided above, a *prima facie* case of obviousness has not been made. Applicant respectfully requests the withdrawal of the nonstatutory obviousness-type double patenting rejection.

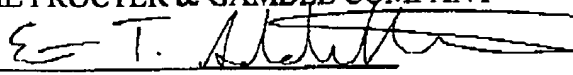
CONCLUSION

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, reconsideration of this application and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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